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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 92061955 |
| Party | Plaintiff DFASS Brands Holdings, LLC |
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| Date | 12/24/2015 |
| Attachments | (Doc 8) Response to Motion to Suspend.pdf(400758 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

DFASS Brand Holdings, LLC, a Florida
limited liability company,

Petitioner,

and

Reginald Williams, an individual,

Registrant.

In the matter of Registration No.
4313253

For the mark TIME TRAVEL ACADEMY

Registered on April 2, 2013

Cancellation No. 92061955

**PETITIONER’S MEMORANDUM OF LAW IN OPPOSITION TO REGISTRANT’S
“MOTION TO SUSPEND PROCEEDING IN VIEW OF
PENDING CIVIL ACTION PURSUANT TO 37 C.F.R. 2.117”**

Petitioner, DFASS Brand Holdings, LLC (“Petitioner”), hereby respectfully submits this Memorandum of Law in opposition to Registrant’s “Motion to Suspend Proceeding in View of Pending Civil Action Pursuant to 37 C.F.R. 2.117.” While this cancellation proceeding before the U.S. Trademark Trial and Appeal Board (Cancellation Action No. 92061955) (the “TTAB Proceeding”) involves the same parties and the same trademark serial number as the subsequently filed, though unserved, civil action pending in the United States District Court of the Northern District of Texas (the “Civil Action”), Respondent has not set forth a valid basis for the suspension of this proceeding. To the contrary, for purposes of judicial efficiency and economy, and for purposes of logical consideration of the issues ripe for adjudication, Petitioner respectfully opposes to Registrant’s motion to suspend the TTAB Proceeding.

In this forum, Petitioner filed its petition seeking to cancel Registrant’s Trademark, “TIME TRAVEL ACADEMY” (the “Mark”) pursuant to Section 14 of the Lanham Act, 15

U.S.C. Section 1064 on the grounds that the Mark is not registrable due to the Mark's entirely descriptive nature, the Mark's lack of distinctive nature, and lack of secondary meaning. In the unserved Civil Action, Registrant apparently alleges trademark infringement, trademark dilution, unfair competition, false advertising pursuant to federal law, unfair competition, and common law trademark infringement under Texas State law. Respondent's Civil Action, however does not raise the issues asserted in this TTAB Proceeding, either by declaratory action or otherwise. The determination of the validity of the Mark in this TTAB Proceeding is plainly the threshold question in this matter; if the Mark is cancelled, there can be no infringement, dilution, or unfair competition¹. Respondent's argument in its Motion is exactly backwards; the issues in this TTAB Proceeding must be resolved *before* the issues raised in the Civil Action can be addressed.

Prior to addressing any claim for infringement of the Mark, the initial consideration must be whether there is actually a valid Mark subject to infringement. This sequential logic necessitates completion of the TTAB Proceeding prior to the completion of the Civil Action. In light of the fact that the Civil Action contains no identical claims relative to the validity of the Mark and has not progressed beyond the filing of the lawsuit to this point, it is most judicially efficient to go forward with the TTAB Proceeding. *See Kemin Industries, Inc., v. Watkins Products, Inc.*, No. 1-74 CIV. 129, 1974 WL 20194, at *2 (D. Minn. July 8, 1974). In *Kemin*, the *district court action was stayed* so that the threshold issues before the TTAB could be resolved. It is important to note that the question before this tribunal is not, of course, whether or not to stay the district court action. The question is whether it is sensible given the scope and stage of the district court proceedings to stay *this* TTAB Proceeding. Since the TTAB Proceeding in this instance, if resolved in favor of Petitioner, would render the issues in the

¹Petitioner disputes that there has been any infringement notwithstanding or that there is any basis for liability to Respondent.

Civil Action moot, there is no basis to suspend the TTAB Proceeding. *Id.* Since the district court action has only been filed and includes *no* claim for declaratory relief or for determination of the validity of the Mark, there is no basis by which the district court's jurisdiction would justify suspension of this proceeding.

Furthermore, the TTAB is the best judicial forum to decide the issues concerning the cancellation claims because this threshold question lies wholly within the TTAB's field of expertise. *Id.* The TTAB is a competent tribunal whose expertise is to determine the validity of trademarks. "Every court is vested with the power to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants." *See Landis v. N. Am. Co.*, 299 U.S. 248, 254 (1936). It is in the best economic and time interests of the parties and the tribunals involved to resolve the cancellation claim in the TTAB prior to taking any further steps because doing so simplifies the issues. It certainly defies all logic to *suspend* the TTAB Proceeding without resolving the threshold question of the Mark's validity. Regardless of the outcome of the TTAB Proceeding, the issues raised in that proceeding must be resolved before any claim of infringement can be finally adjudicated. In addition, the litigants will bear less of a financial burden if the matters are resolved in the TTAB. A determination by the TTAB prior to the determination of the pending Civil Action would also avoid inconsistent results.

Section 2.117(a) of C.F.R. Title 37, which Respondent relies upon in support of its Motion is not supportive of Respondent's position. That subsection provides:

whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding **which may have a bearing on the case**, proceedings before the Board may be suspended until termination of the civil action or the Board other Board proceeding.

(Emphasis added). In this case, the Civil Action does not have a bearing on the TTAB Proceeding. Conversely, the Civil Action rests on the incorrect presumption that the issues

pending in this TTAB Proceeding have already been resolved (in Respondent's favor).

Therefore, it would be inefficient to litigate the Civil Action before the cancellation issue is resolved because the Civil Action issues are non-issues if there is no Mark.

WHEREFORE, Petitioner respectfully requests that Respondent's Motion be denied.

Respectfully submitted,

MARKO & MAGOLNICK, P.A.

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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing is being served on December 23, 2015, by email (jjzito@dnlzito.com) and by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Respondent at:

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